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AUG 31 2006

Serial No. 09/938,454

Claims 1-24 remain in this application.

Rejections Under 35 USC 102(e)

I

Claims 1-8 and 13-20 were rejected under 35 USC 102(e) as being anticipated by Collin (US Patent No. 6,491,931). See Pages 2-5 of the Office Action. Applicants respectfully disagree.

According to the Office Action, the cosmetic composition of Collin "read on Applicant's claims 1-8, which recite a mascara comprising less than about 1%, by weight, of wax." See page 4 of the Office action. Claim 1, from which claims 7-8 and 13-20 depend, however recites a "mascara comprising a silicone gel that comprises an organopolysiloxane elastomer and a silicone oil, wherein said mascara comprises less than about 1%, by weight, of wax." Collin fails to disclose, or suggest, such a mascara which comprises such a silicone gel while comprising less than about 1%, by weight, of wax. While Collin does disclose the use of silicone oils, Collin does not disclose silicone gels comprising an organopolysiloxane elastomer and a silicone oil, as recited in claim 1 of the present invention. In addition, none of the Examples of Collin recite such a silicone gel.

Accordingly, Applicants respectfully request that such rejection under 35 USC 102(e) be withdrawn.

II

Claims 1, 2, 5, 6, 9, 10, 13, 14, 17, 18, 21, and 22 were rejected under 35 USC(e) as being anticipated by Shah et al. (US Patent No. 6,387,405). See Pages 5-7 of the Office Action. Applicants respectfully disagree.

As noted in the Office Action, Shah et al does disclose "[t]he compositions of the present invention can be used in any type of makeup or, skin or sun care product. Typical examples include foundations, eyeshadows, eyeliners, mascaras, blushes, powders, lipsticks, lipglosses, lip paints, oil control skin mattifiers, and sunscreen lotions." However, no examples of mascaras are disclosed in Shah et al. Thus, Shah et al. does not teach any mascara. In fact, the only examples disclosed in Shah et al. are skin foundations and lip

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paints, which are not mascaras. Thus, one of ordinary skill in the art would not look to Shah et al. as a teaching, or suggesting, the claimed mascaras of the present invention. Accordingly, Applicants respectfully request that such rejection under 35 USC 102(e) be withdrawn.

Rejection Under 35 USC 103**I**

Claims 1-24 remained rejected under 35 USC 103 as being unpatentable over Sunkel et al. (U.S. Patent No. 6,542,598). See Pages 7-9 of the Office Action. Applicants again respectfully disagree as set forth in the prior responses filed on May 3, 2005 and November 22, 2005 ("Prior Response").

According to the Office Action, "Sunkel et al. teach cosmetic compositions comprising organopolysiloxane elastomers and silicone oils wherein the composition may be in the form of a foundation, mascara, eye shadows, powders, blushes, lip color, and the like. . . . Example II at column 23 demonstrates a mascara composition comprising elastomer gels, silicone oils, pigments, and the like. . . . Applicant's have not demonstrated any criticality based on the claimed invention of less than about 1%, by weight, or wax." See Page 7 of the Office Action.

In the Prior Response, Applicants submitted a Declaration Under 37 CFR 1.132 by Lien Ly ("Declaration"), which demonstrated that the viscosity of the Wax Mascara increased on average by over one hundred percent, while the Wax-free Mascara, unexpectedly only increased on average nineteen percent (five times less than the Wax Mascara). In response to the Prior Response, the Office Action stated that the Declaration had been fully considered but was not deemed persuasive, as "Sunkel et al. teach '0 to 90% of solidifying agents, of which waxes are included.'" See Page 13 of the Office Action. However, as previously argued, Sunkel et al. relates to various types of cosmetic compositions. Sunkel et al. does not disclose, nor suggest, how one would make a mascara with 0% wax. In fact, Sunkel et al. actually teaches away from such as the mascara set forth in Example II of Sunkel et al. comprises 11.25% of wax. Thus, Sunkel et al. does not teach, nor suggest, the mascara recited in independent claim 1 of the present application, which "comprises less than about 1%, by weight, of wax."

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The Office Action continues to state "the prior art initially recognizes and discloses make-up products, such as mascaras, which contain minute amounts or no amounts of wax at all." See page 13 of the Office Action. The Office Action continues to state that "the prior art explicitly demonstrate objective for obtaining cosmetic compositions hat incorporate no wax or less amounts of wax to avoid heavy or dragging fell of make-up upon application." See Page 14 of the Office Action. While, Applicants do not deny that there is a long-felt need for reduced-wax mascaras, none of the prior art cited herein enable one of ordinary skill in the art to make such as mascara as claimed invention of this application.

For the reasons set forth above, the claimed invention is not obvious in light of Sunkel et al., and Applicants respectfully request that the above rejection under 35 USC 103(a) be withdrawn.

II

Claims 1-24 were rejected under 35 USC 103 as being unpatentable over Collin in view of Shah et al. See page 9-11 of the Office Action. Applicants respectfully disagree. As discussed above, neither Collin nor Shah et al. disclose, nor suggest, a reduced-wax mascara comprising the claimed silicone gel. In fact, Shah et al. fails to disclose the manufacture of any mascara.

Accordingly, the claimed invention is not obvious over Collin in view of Shah et al, and Applicants respectfully request that the above rejection under 35 USC 103(a) be withdrawn

Applicants also respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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